

P A T E N T
HER07 P-106

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Confirmation No. : 5284
Art Unit : 1771
Examiner : Alexis A. Wachtel
Applicants : Birgit Boge, Jurgen Trappmann, and Wolfgang Holst
Serial No. : 09/647,209
Filed : September 27, 2000
For : **MARKINGS ON MINERAL WOOL PRODUCTS**
Atty Docket No. : HER07 P-106

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Commissioner for Patents
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Dear Sir:

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on November 14, 2003.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Attention: Board of Patent Appeals and Interferences

REPLY BRIEF

This reply brief is being submitted in response to the Examiner's Answer mailed October 2, 2003, for the above-identified patent application.

Claims 1, 2, and 8-35 were rejected under 35 USC §103(a) for allegedly being obvious based on three separate grounds. First, they were rejected for allegedly being obvious in light of U.S. Patent No. 4,866,905 issued to Bihi. Second, they were rejected for allegedly being obvious in light of German reference DE 3713108A. Third, they were rejected for allegedly being obvious in light of European Patent Publication EP 795424 A1. For all three of these rejections, the Examiner has refused to accord patentable weight to the specifically claimed graphical markings in Applicants' invention because they allegedly do not structurally affect the final product, and because " they do not contribute to the function of the claimed product over and above what is taught in the applied art for such markings." (Examiner's Answer, page 3). Applicants respectfully disagree.

The subject matter of the presently appealed claims relates to insulation material sheets that have graphical markings that indeed do contribute to the function of the claimed product over and above what is taught in the three cited references. As set forth in the Bihi '905 patent, the German '108 reference, and the European '424 reference, each of these prior art references discloses graphical markings that facilitate cutting the insulation sheet material only in the direction that is perpendicular to the longitudinal axis of the sheet material. None of the three references disclose, teach, or suggest markings that facilitate the cutting of the

sheet material in non-perpendicular directions. The function of the presently claimed subject matter is thus different from the function of the subject matter disclosed in these three prior art references.

The Examiner has mistakenly assumed that the graphical markings in the present invention function the same as those in the prior art. On page 7 of the Examiner's Answer, the Examiner writes:

In fact, the Applicant does not dispute that the indicia of Applicant's article functions identically to that disclosed by the relied on prior art. Had the applied prior art not anticipated this functional relationship instantly claimed, the Examiner would agree that the current rejections fail.

The Examiner has misunderstood the substance of the Applicants' argument. Nowhere have the Applicants agreed that the indicia of the present invention function identically to that disclosed in the prior art. Quite to the contrary, Applicants specifically dispute that the indicia of the present application function identically to that disclosed in the prior art. As set forth above, the function of the present invention is completely different from the function disclosed in the references relied upon by the Examiner. Because the applied prior art does not anticipate or suggest the function of the presently claimed subject matter, the current rejections must fail.

Applicants further disagree with the Examiner's interpretation of the *In re Miller* case. At page 6 of the Examiner's Answer, the Examiner asserts that the *In re Miller* case sets forth three implicit requirements for making claim rejections based on printed matter. The third alleged requirement is identified as follows:

[The printed matter] indicia must conceptually serve the same purpose as Applicant claims be it decorative or functional.

Applicants respectfully disagree with this statement, not because it is inherently wrong, but rather because it is incomplete, and thus inaccurate. The *Miller* case requires that the prior art does more than merely "serve the same purpose" as an applicant's invention. Rather, the *Miller* case stands for the proposition that the prior art must perform the same function as is set forth in the applicant's claims. Here, as discussed above, the three references cited by the Examiner do not perform the same function. They therefore do not anticipate or render obvious the subject matter claimed in the pending application and the rejection of these claims is improper.

The facts of the *In re Miller* case clearly demonstrate that more is required of the prior art printed matter than for it merely to "serve the same purpose" as the printed matter in the applicant's claims. Were it otherwise, the applicant in *Miller* would never have received a patent. In the *Miller* case, the appealed invention related to a measuring cup that facilitated measuring ingredients for fractional recipes. The purpose of the applicant's invention in *Miller*, however, was the same purpose as that which had been fulfilled by the prior art measuring cups: the prior art measuring cups measured volumes; the applicant's measuring cup measured volumes. Furthermore, they both allowed measurements to be made of less than one cup, and they both could be used to make any given recipe. They both, therefore, served the same purpose. Thus, if the applicant's printed indicia merely had to "serve the same purpose" as the prior art printed indicia in order for a claim to be properly rejected, as the Examiner now contends, the applicant in *Miller* would never have obtained a patent. The Examiner's interpretation of the *Miller* case is therefore incorrect. The correct interpretation is that the prior art printed matter must not only serve the same purpose, but it must also perform the same function as the printed matter in the claimed invention. Only then can a proper rejection can be made.

This is clear upon an examination of the reasoning behind the *In re Miller* case. The reason why the applicant in *Miller* obtained a patent was because the prior art did not disclose printed matter that served the same specific function as the printed matter did in the applicant's invention. The prior art measuring cups had disclosed cups with printed matter identifying standard fractions of a cup, such as one-third, one-fourth, one-sixth, and so on. What the prior art failed to disclose, however, was a measuring cup that included printed matter that facilitated the measuring of fractions of these standard gradations. Thus, if a recipe called for two-thirds cup water, and the cook was seeking to make only one-third of the full recipe, he was left, if he used the prior art measuring cups, with the unenviable task of trying to measure one-third of two-thirds (i.e. two-ninths)—an amount not typically included on a standard measuring cup. The markings on the prior art measuring cups thus did not facilitate this task. The markings on the inventor's new measuring cup, in contrast, did facilitate this purpose. Thus, the applicant in *Miller* invented a measuring cup whose printed matter functioned in a new and non-obvious manner. While the new measuring cup also "conceptually serve[d] the same purpose" as the prior art measuring cups—i.e. measuring volumes—this was not a bar to patentability because the applicant's measuring cup performed a new and non-obvious function. This establishes the incorrectness of rejecting

claims simply because the prior art shows printed matter that serves the same general purpose as the claimed invention, as the Examiner has done in the present case.

Therefore, in the present case, the fact that the prior art shows insulation sheet materials with printed matter that serves the same general purpose of facilitating cutting is in no way a proper reason to reject the pending claims. The markings on Applicants';*p3750X insulation function differently than those of the prior art. The markings on Applicant's insulation function in a new and non-obvious manner, just as the markings did in the *Miller* case. Specifically, Applicants' markings facilitate the making of cuts in the insulation that are not perpendicular to the longitudinal extent of the insulation sheet. Because they operate to provide a new and non-obvious function, it is improper to reject them based on prior art references that only disclose markings for performing a different function, i.e. cutting the insulation in a perpendicular direction.

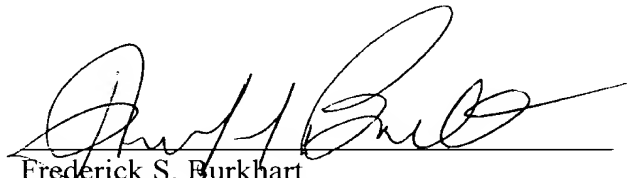
For all of the foregoing reasons, Applicants submit that the Examiner's rejections of the pending claims are improper, and consequently should be withdrawn.

Respectfully submitted,

BIRGIT BOGE, JURGEN TRAPPMANN,
AND WOLFGANG HOLSTEIN

By: Van Dyke, Gardner, Linn & Burkhart, LLP

Date: November 14, 2003.



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